



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,344	12/22/2000	Peter Zhu	ASP-0010	1705

7590 03/31/2003

Philip S. Johnson
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

EXAMINER

BARRY, CHESTER T

ART UNIT

PAPER NUMBER

1724

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,344

Applicant(s)

ZHU ET AL.

Examiner

Chester T. Barry

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The objection to claim 28 is withdrawn.¹

The rejection of claim 22 under Sec 102 over Shi is maintained.

Applicant argues that the recitation of "a solid primary amine neutralizes and removes the aldehyde from the waste stream" is not merely a matter of intended use "because the presence and removal of an aldehyde from a waste stream is part of the body of claim 22." This argument is unpersuasive for several reasons. First, the examiner does not agree with the premise that "an aldehyde" is an element of the device of claim 22. Yes, the word "aldehyde" is present in claim 22 by virtue of the letters A – L – D – E – H – Y – D – E (in the recited order) appearing in the text of claim 22, I grant you that. But that does not make the presence of an aldehyde in the structure of the claimed device a narrowing limitation of the claim any more than the recitation of "waste stream" narrows the scope of the device. If such were the case, then an unlicensed person making and selling a container with an inlet and an outlet and a closing lid or cover which enclosed a quantity of a solid primary amine and neutralized aldehyde of unknown origin would not directly infringe the claim for want of a "waste stream" contained therein. By analogy, a rotary dial telephone capable of being dialed to call 1-800-555-1212 does not perform the act of dialing that or any other number: That act is left to the person using the telephone. The method of using a

¹ Objection under 37 CFR 1.121 for applicant's improper underlining of added text and bracketing of deleted text in claim 28 is waived. It should have appeared as "... animated polysaccharides ..." or "... animated [polysaccharides] polysaccharides ..." but not "... ~~animated polysaccharides~~ animated polysaccharides ..." (text additions not underlined).

rotary dial telephone to call 1-800-555-1212 is an invention other than the telephone itself.

Alternatively, if one were to adopt applicant's reasoning, an unlicensed person who performed the acts of passing a product stream (rather than a waste stream) through a container having an inlet, an outlet, and some solid primary amine enclosed therein which neutralized aldehyde in the product stream, perhaps one even having an inlet funnel and an outlet valve identical to that shown in applicant's figure 2, then such a person would not directly infringe claim 22 for want of the stream from which the aldehyde was neutralized to be fairly characterized as a "waste" stream. For the foregoing reasons, applicant's attempt through argument to narrow the scope of device claim 22 by the attributes of a process methodology are unpersuasive. If applicant wishes to narrow the scope of the device to one containing a waste stream having an aldehyde therein, applicant is welcomed to do so. But be aware that such a claim would be considered by the examiner to be directed to the non-elected invention and held withdrawn from consideration in this proceeding.

The §103 rejection of claims 22 – 26, 31 over Shi and Portier is incorporated here by reference and maintained. Applicant argues that the claimed device "physically removes the aldehydes present in waste." The claims 22 – 26, 31 are not so limited. See the examiner's response to the §102 rejection arguments above.

The obviousness type double patenting rejection is maintained. It would have been obvious to have provide the patented system of claim 15 with an inlet and outlet an to have used solid form of amine.²

The §103 rejection of claims 22-24, 31 over King, Wu and Nagata is repeated and maintained. The examiner disagrees that these references do not provide sufficient motivation to render the claimed invention as a whole obvious under §103.

The §102(e) rejection of claims 22 – 24, 31 over Chen is repeated and maintained.

Applicant argues that claim 22 requires that the solid primary amine is “immobilized” in the container. Is that what “enclosed” means?³ The examiner requests applicant to inform the examiner which words – either by express recitation or by way of implication - require that claim 22's solid primary amine be immobilized within the container. The argument is unpersuasive because it appears that applicant is arguing features that do not limit the scope of claim 22.

The rejections under §102 over Decor or Pirkle are incorporated herein by reference.

² Erratum: At page 7, text line 4, the examiner referred to “Claim 22.” “Claim 15” was intended.

³ My dog may be enclosed within my house while I'm at work, for I do not have a “doggie door” (as shown, for example, by Garrison), but she certainly is not immobilized therein: She is free to walk around all she wants – all within the confines of my house.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.